



Docket No.: 50179-087

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Robyn Joyce RUSSELL, et al.

Serial No.: 09/776,910

Filed: February 06, 2001

For: MALATHION CARBOXYLESTERASE

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Group Art Unit: 1652

Examiner: Rao, Manjunath N.

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MAR 27 2003

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RESPONSE TO RESTRICTION REQUIREMENT

Honorable Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

In response to the non-final Office Action mailed on February 26, 2003, setting forth a restriction requirement, Applicants hereby elect, with traverse, Group I (claims 9 and 13-18) for prosecution on the merits.

Applicants respectfully submit that the restriction requirement between asserted patentably distinct inventions is proper only when there is a serious burden on the Patent Office to examine all of the claims in a single application even when it appears that appropriate reasons exist for a restriction requirement. M.P.E.P. §803. To avoid unnecessary delay and expense to the Applicants and duplicative examination by the Patent Office, Applicants respectfully request that the above policy be applied in the present application because the subject matter of the pending claims is sufficiently related.

For instance, Group I is directed to an enzyme capable of hydrolyzing at least one organophosphate and Group II is directed to a method of eliminating or reducing the concentration of organophosphates pesticide residues in a contaminated sample or substance with the enzyme of Group I. Applicants respectfully submit that the non-burdensome search for Group I would necessarily overlap with Group II because both groups are directed to an enzyme capable of hydrolyzing at least one organophosphate.

Furthermore, during the prosecution of the parent application, U.S. Patent Application No. 09/068,960 filed May 20, 1998 (now U.S. Patent No. 6,235,515), the Examiner asserted that inventions of an enzyme capable of hydrolyzing organophosphates and methods of using said enzyme in reducing the concentration of organophosphates in a sample (i.e., Group I and Group II, respectively) were considered a single invention. See attached copy of the Restriction Requirement dated October 6, 1999. Applicants respectfully submit that based on the Examiner's previous assertion, the present application was filed on the assumption that the pending claims define a single invention.

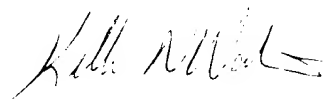
Accordingly, Applicants respectfully submit that further division of the claimed invention would be unreasonable in view of the related subject matter of the Group I and II and the prior assertion that the subject matter of Groups I and II comprises a single invention. Applicants respectfully request reconsideration and withdrawal of the restriction.

CONCLUSIONS

Please grant any extension of time necessary for entry of this communication.
Please charge any deficit fees, or credit any overpayment of fees, to Deposit Account No. 500417.

Respectfully submitted,

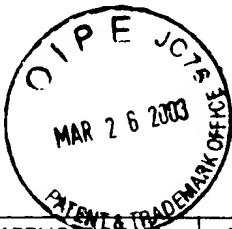
McDERMOTT, WILL & EMERY



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Date: March 26, 2003

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Rest. Reg. 11/6k
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/068,960	05/20/98	RUSSELL	R 1451036

50179-051

020277
MODERMOTT WILL & EMERY
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WASHINGTON DC 20005-3096

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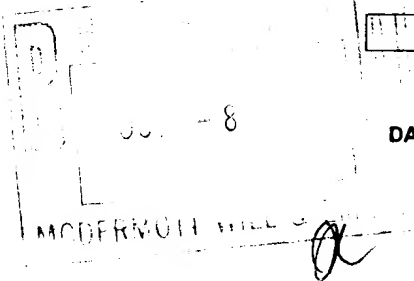
EXAMINER

RAC, M

ART UNIT	PAPER NUMBER
1652	8

DATE MAILED:

10/06/99

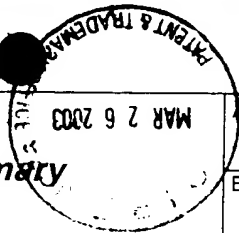


Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary



Application No.
09/068,960

Applicant(s)
Russel et al.

Examiner
Manjunath Rao

Group Art Unit
1652



☒ Responsive to communication(s) filed on Aug 30, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-12 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Serial No.: 09/068,960

Art Unit: 1652



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DETAILED ACTION

Election/Restriction

1. This application was filed as subject to 35 U.S.C. § 371 (see MPEP § 1895.01). Unity of
5 invention as provided for by 37 C.F.R. 1.475 must be present, as cited below:

Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.

10 a. An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical
15 features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

20 b. An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- i. A product and a process specially adapted for the manufacture of said product; or
- ii. A product and a process of use of said product; or
- 25 iii. A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- iv. A process and an apparatus or means specifically designed for carrying out the said process; or
- v. A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying
30 out the said process.

35 c. If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph b of this section, unity of invention might not be present.

d. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and 1.476(c).

40 e. The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

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Group I. Claims 1-8 and 12, drawn to polynucleotides encoding an enzyme, and method of producing the enzyme by recombinant techniques, classified in class 536, subclass 23.2.

5 Group II. Claims 9-11, drawn to an enzyme capable of hydrolysing organophosphates and methods of using the said enzyme in reducing the concentration of organophosphates in a sample in class 435, subclass 197.

10 The inventions are distinct, each from the other because of the following reasons:

2. Group I is a product and a process of use; these share the special technical feature of the DNA molecules, which group II does not share.

15 Group II is a product and process of use; this shares the special technical feature of the enzyme, which group I does not share.

Therefore, the claims are not so linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single inventive concept.

20 3. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the
25 currently named inventors is no longer an inventor of at least one claim remaining in the

Art Unit: 1652

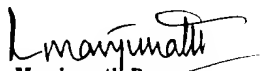
application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

5. Any inquiry concerning this communication or earlier communications should be directed to Manjunath Rao whose telephone number is (703) 306-5681. The examiner can normally be reached on Mondays through Thursdays from 6:30 a.m. to 3:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission to the attention of the examiner in Art Unit 1652. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (October 19, 1988) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The FAX telephone number is (703) 308-4242. Note: If applicants do submit a paper by facsimile, the original signed copy should be retained by applicants or applicants' representative. No duplicate copies should be submitted so as to avoid the processing of duplicate papers in the Office.


Manjunath Rao
Art Unit 1652.

October 1, 1999


PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600